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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,450	01/16/2004	Edward B. Kollin	LUB-100-A	7725

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EXAMINER

FISCHER, JUSTIN R

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/759,450

**Applicant(s)**

KOLLIN, EDWARD B.

**Examiner**

Justin R Fischer

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102/103*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fricke (EP 210356, newly cited). Fricke teaches a lubricant composition for a tire consisting of (i) a polyglycol and/or a polyglycol ether (carrier fluid) between 50 and 80 weight percent, (ii) a metal soap (thickener) between 20 and 50 weight percent, and (c) a surfactant between 1 and 3 weight percent (Abstract). In this instance, Fricke discloses a lubricant composition in the same environment and having the same components in the same amounts as compared to the composition of the claimed invention and as such, one of ordinary skill in the art at the time of the invention would have expected the composition of Fricke to exhibit the claimed viscosity and shear thinning characteristic (properties would

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naturally flow from the selection of such a composition). It is further noted that the viscosity appears to be dependent on the specific composition and not on any unique processing, further suggesting that the composition of Fricke would satisfy the properties of the claimed invention. However, it is agreed that Fricke fails to expressly describe the viscosity and shear thinning characteristic of the composition. In any event, one of ordinary skill in the art at the time of the invention would have found it obvious to form the lubricant of Fricke in accordance to the claimed invention since the reference desires a lubricant having a high viscosity over a wide range of temperatures such that the flow properties are not too high and said lubricant remains in place during long running periods (Abstract)- this is analogous to the desire of the claimed invention. Furthermore, as noted above, the components of Fricke appear to be substantially the same as those of the claimed invention. Therefore, it would have been obvious to form the lubricant of Fricke with a viscosity and shear thinning characteristic as set forth in the claimed invention.

Regarding claims 2 and 3, Fricke discloses the use of a polyglycol and/or a polyglycol ether. It is unclear if the reference discloses the species listed in claim 3; however, the species listed in claim 3 fall within the genus of polyglycols and polyglycol ethers and one of ordinary skill in the art at the time of the invention would have found it extremely obvious to chose any of the claimed components (e.g. polyglycols= polyethylene glycol, polypropylene glycol, polybutylene glycol, polyhexylene glycol).

As to claim 4, Fricke discloses a carrier fluid in an amount between 50 and 80 weight percent, which is fully incorporated in the broad range of the claimed invention.

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Regarding claims 5 and 8, Fricke suggests the use of a metal soap or thickener in an amount between 20 and 50 weight percent, which is nearly fully incorporated in the broad range of the claimed invention.

4. Claims 1-4 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Matzat (DE 3914887, newly cited). Matzat teaches a lubricant composition consisting of a carrier fluid (polyglycol), a non-ionic wetting agent (surfactant), a thickener, and an organic amine. In this instance, the present of between 0.2 weight percent and 2.0 weight percent of an organic amine is not seen to affect the basic and novel characteristic of the lubricant composition- thus, the reference teaches a lubricant composition consisting essentially of a carrier fluid, a surfactant, and a thickener. In this instance, Matzat discloses a lubricant composition in having the same components in the same amounts as compared to the composition of the claimed invention and as such, one of ordinary skill in the art at the time of the invention would have expected the composition of Matzat to exhibit the claimed viscosity and shear thinning characteristic (properties would naturally flow from the selection of such a composition). It is further noted that the viscosity appears to be dependent on the specific composition and not on any unique processing, further suggesting that the composition of Matzat would satisfy the properties of the claimed invention. However, it is agreed that Matzat fails to expressly describe the viscosity and shear thinning characteristic of the composition. In any event, one of ordinary skill in the art at the time of the invention would have found it obvious to form the lubricant of

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Matzat in accordance to the claimed invention since the components of Matzat appear to be substantially the same as those of the claimed invention.

***Claim Rejections - 35 USC § 103***

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fricke as applied in the rejection of claim 5 above and further in view of either one of Jones (US 3,954,638, newly cited) or Fahl (US 4,784,795, newly cited). As previously noted, Fricke is directed to a lubricant composition including a thickener in the form a metal soap. While the reference is silent as to the use of alternative thickeners, it is extremely well known in the lubricating industry that a wide variety of thickeners (recognized as equivalents) are commonly employed, as shown for example by Jones (Column 3, Lines 15-30) or Fahl (Column 3, Lines 9-30). It is emphasized that both references suggest the alternative use of metal soaps and clays, particularly bentonite clay. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a clay thickener (in place of a metal soap) in the lubricant composition of Fricke, there being no conclusive showing of unexpected results to establish a criticality for the claimed lubricant composition.

6. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fricke as applied in claim 1 above and further in view of Lentsch (US 6,664,219). As noted above, Fricke teaches a lubricant composition having a surfactant, particularly a non-ionic surfactant. One of ordinary skill in the art at the time of the invention would have found it obvious to use a silicone surfactant, more preferably an alkoxylated silicone surfactant, since these surfactants represent well known non-ionic surfactants

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that are extensively used in a wide variety of industries, as shown for example by Lentsch (Column 6, Lines 20-40). Absent any conclusive showing of unexpected results, it would have been within the purview of one of ordinary skill in the art at the time of the invention to appropriately select the specific type of surfactant from the large number of well known surfactants.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fricke as applied in claim 1 above in view of either one of Jones or Fahl and further in view of Lentsch. As previously noted, the lubricant of Fricke includes a thickener (metal soap) and a non-ionic surfactant. While Fricke fails to suggest the claimed thickener and surfactant, the respective components are commonly employed in a wide variety of lubricant compositions and as such, one of ordinary skill in the art at the time of the invention would have found it obvious to use a clay thickener and a silicone surfactant in view of either one of Jones or Fahl and Lentsch, respectively. Lastly, applicant has not provided a conclusive showing of unexpected results to establish a criticality for the claimed composition.

8. Claims 12-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Admitted Prior Art (Page 1, Paragraph 4) and further in view of Fricke. The APA generally describes the known use of a lubricant between a tire inner surface and a runflat device disposed therein in order to prevent heat buildup. In this instance, though, the APA fails to detail the specific lubricants used in these environments. Fricke, on the other hand, discloses a lubricant composition between a tire inner surface

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and a rim comprising a carrier fluid, a thickener, and a surfactant (Abstract). One of ordinary skill in the art at the time of the invention would have found it obvious to use the lubricant of Fricke in the runflat tire described by the APA since it represents a lubricant used in the tire industry that provides sufficient lubricity between a tire inner surface and a device or object disposed therein, there being a reasonable expectation of success. It is emphasized that Fricke is directed to a lubricant for reducing friction between the inner wall of a tire and the rim or other parts of the tire- thus Fricke generally envisioned the use of such a lubricant in a tire to prevent the occurrence of friction. As such, the particular selection of such a lubricant in a runflat tire between the inner wall of the tire and the runflat device (other part of the tire) would have been well within the purview of one of ordinary skill in the art at the time of the invention.

9. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the APA and Fricke as applied in claim 16 above and further in view of either one of Jones or Fahl. The APA in view of Fricke discloses a runflat tire construction having a lubricant composition consisting of a carrier fluid, a thickener, and a surfactant, wherein said thickener is a metal soap. While Fricke is silent as to the use of alternative thickeners, it is extremely well known in the lubricating industry that a wide variety of thickeners (recognized as equivalents) are commonly employed, as shown for example by Jones (Column 3, Lines 15-30) or Fahl (Column 3, Lines 9-30). It is emphasized that both references suggest the alternative use of metal soaps and clays, particularly bentonite clay. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a clay thickener (in place of a metal soap) in the



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lubricant composition of Fricke, there being no conclusive showing of unexpected results to establish a criticality for the claimed lubricant composition.

10. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the APA and Fricke as applied in claim 13 above and further in view of Lentsch. As noted above, the APA in view of Fricke teaches a runflat tire construction in which the claimed lubricant is arranged between the tire's inner surface and a runflat device disposed therein. In describing the surfactant, Fricke broadly suggests the use of a non-ionic surfactant- the reference fails to expressly suggest a list of suitable surfactants. One of ordinary skill in the art at the time of the invention would have found it obvious to use a silicone surfactant, more preferably an alkoxylated silicone surfactant, since these surfactants represent well known non-ionic surfactants that are extensively used in a wide variety of industries, as shown for example by Lentsch (Column 6, Lines 20-40). Absent any conclusive showing of unexpected results, it would have been within the purview of one of ordinary skill in the art at the time of the invention to appropriately select the specific type of surfactant from the large number of well known surfactants.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the APA and Fricke as applied in claim 12 above in view of either one of Jones or Fahl and further in view of Lentsch. As previously noted, the lubricant of Fricke includes a thickener (metal soap) and a non-ionic surfactant. While Fricke fails to suggest the claimed thickener and surfactant, the respective components are commonly employed in a wide variety of lubricant compositions and as such, one of ordinary skill in the art at

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the time of the invention would have found it obvious to use a clay thickener and a silicone surfactant in view of either one of Jones or Fahl and Lentsch, respectively. Lastly, applicant has not provided a conclusive showing of unexpected results to establish a criticality for the claimed composition.

12. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matzat as applied in claim 2 above and further in view of either one of Jones or Fahl. As previously noted, Matzat is directed to a lubricant composition including a thickener- the reference, however, is silent as to any specific thickeners. In any event, it is extremely well known in the lubricating industry that a wide variety of thickeners, including clays, are commonly employed, as shown for example by Jones (Column 3, Lines 15-30) or Fahl (Column 3, Lines 9-30). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a clay thickener in the lubricant composition of Matzat, there being no conclusive showing of unexpected results to establish a criticality for the claimed lubricant composition.

13. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matzat as applied in claim 1 above and further in view of Lentsch. As noted above, Matzat teaches a lubricant composition having a surfactant, particularly a non-ionic surfactant. One of ordinary skill in the art at the time of the invention would have found it obvious to use a silicone surfactant, more preferably an alkoxylated silicone surfactant, since these surfactants represent well known non-ionic surfactants that are extensively used in a wide variety of industries, as shown for example by Lentsch

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(Column 6, Lines 20-40). Absent any conclusive showing of unexpected results, it would have been within the purview of one of ordinary skill in the art at the time of the invention to appropriately select the specific type of surfactant from the large number of well known surfactants.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matzat as applied in claim 1 above in view of either one of Jones or Fahl and further in view of Lentsch. As previously noted, the lubricant of Matzat includes a thickener and a non-ionic surfactant. While Matzat fails to suggest the claimed thickener and surfactant, the respective components are commonly employed in a wide variety of lubricant compositions and as such, one of ordinary skill in the art at the time of the invention would have found it obvious to use a clay thickener and a silicone surfactant in view of either one of Jones or Fahl and Lentsch, respectively. Lastly, applicant has not provided a conclusive showing of unexpected results to establish a criticality for the claimed composition.

15. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wavin (NL 7902120, newly cited) and further in view of O'Bryant (US 6,124,248, newly cited). Wavin teaches a lubricant composition for joining pipes comprising a water-miscible compound, such as a polyhydric alcohol, and a thickener in an amount greater than 10 weight percent, preferably a bentonite clay (Abstract). While Wavin fails to include a surfactant, such a component represents an extremely common additive that is extensively used in lubricant compositions in the pipe joining industry, as shown

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for example by O'Bryant (Column 8, Lines 40-63 and Column 10, Lines 10-27). As such, one of ordinary skill in the art at the time of the invention would have found it obvious to include a surfactant in the lubricant composition of Wavin, it being well recognized that they provide uniform coverage of a given lubricant and improve release properties. In regards to the properties of the lubricant composition, one of ordinary skill in the art at the time of the invention would have expected the lubricant of Wavin to exhibit the claimed viscosity and shear thinning characteristic since the lubricant of Wavin contains substantially the same components as the lubricant of the claimed invention, there being no evidence of any unique processing. Lastly, applicant has not provided a conclusive showing of unexpected results to establish a criticality for the claimed lubricant composition.

### ***Response to Arguments***

16. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection. As amended, the claim requires a lubricant "consisting essentially of" a carrier, a thickener, and a surfactant- the previous rejections have been withdrawn in light of the above noted amendment and a series of new rejections have been set forth above. Regarding the claims pertaining to a runflat tire, the claims have been amended to require a specific viscosity and shear thinning characteristic- the previous rejections have been withdrawn in light of the above noted amendment and a series of new rejections have been set forth above.

***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Justin Fischer

March 1, 2005

  
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PRIMARY EXAMINER  
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